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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,157	04/28/2005	Akio Ozasa	12480-00055/US	5698
36593 7590 11/27/2007 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195				
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
11/27/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/505,157

Applicant(s)

OZASA ET AL.

Examiner

Anish Desai

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 09/11/07. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/11/07 has been entered.
2. Claims 1-22 are pending. Support for the amended claims is found in the specification.
3. All of the previously made art rejections are maintained.
4. The obviousness type double patenting rejections are withdrawn in view of the present amendment and response (see page 11 of 07/25/07 amendment).

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 3, 6, 14, 21, and 22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Doane et al. (US 5,861,216) substantially as set forth in the previous Office Action, together with the following additional observations.

The art rejections of Doane are disclosed in the previous Office Action and they are equally applicable. The presently amended claims include new claim limitations of molded article having an irregular surface (claims 1 and 3) and wherein the irregular surface includes bumps and dips (new claims 21 and 22). This Office Action only addresses the new claim limitations. With respect to claim limitation of molded article having an irregular surface, it is noted that the molded article of Doane as shown in Figure 2 is formed of a foamed material. To the Examiner the foamed material would inherently have an irregular surface. With respect to new claims 21 and 22, the irregular surface including bumps and dips, it is the Examiner's position that in absence of any unexpected results, the biodegradable expanded molded article of Doane as disclosed in the abstract and at column 9 lines 12-13 and that of Applicant is structurally and compositionally equivalent and therefore it would necessarily have irregular surface having bumps and dips. Further, it is known that no surface is perfectly smooth. Thus, the claim limitations of irregular surface would obviously have been present once the biodegradable expanded molded article of Doane is provided.

6. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doane et al. (US 5,861,216) in view of Bradt (US 5,888,599) substantially as set forth in the previous Office Action.

7. Claims 1, 3, 8-12, and 16-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ando et al. (US 5,639,518) substantially as set forth in the previous Office Action.

The art rejections of Ando are previously disclosed in the previous Office Action and they are equally applicable. The presently amended claims include new claim limitations of molded article having an irregular surface (claims 1 and 3). This Office Action only addresses the new claim limitations. With regards to claim requirements of the biodegradable expanded molded article having an irregular surface, it is the Examiner's position that it is known that no surface is perfectly smooth. Therefore, the biodegradable expanded molded article of Ando if not expressly taught, as having an irregular surface, would obviously have an irregular surface.

8. Claims 4, 5, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (US 5,639,518) in view of Shogren et al. (US 6,146,573) substantially as set forth in the previous Office Action.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (US 5,639,518) in view of Altieri (US 5,153,037) substantially as set forth in the previous Office Action.

Response to Arguments

10. Applicant's arguments filed 09/11/07 have been fully considered but they are not persuasive.

With respect to the art rejections based on Ando, Applicant argues, "Ando fails to teach or fairly suggest that the sheets 21 and 22 are heated to, or laminated at, a predetermined temperature. Because the sheets 21 and 22 are laminated to the tray like article by pressure ...tray-like article." According to Applicant because of the molded article produced according to the teachings of Ando have a smooth boundary between the sheets 21 and 22, Ando does not teach or fairly suggests "a biodegradable expanded molded article molded in a specified shape...molded article" as required by claim 1. The Examiner respectfully disagrees. As to Applicant's argument that Ando fails to teach or fairly suggest that the sheets 21 and 22 are heated to, or laminated at a predetermined temperature, these arguments are related to process and they are not commensurate in scope with the claims. Further, as to Applicant's arguments that Ando does not teach or fairly suggest the aforementioned claim limitation of claim 1, as set forth above in Section 7 of this Office Action and in Section 7 of the previous Office Action mailed on 06/13/07, Ando discloses aforementioned claim limitation.

With respect to the art rejections based on Doane, Applicant argues "Doane fails to teach or fairly suggest that the article is prepared by concurrently performing a steam expansion molding operation on the starch and an adhesion operation wherein the coating film is adhered to the surface of the expanded molded article. Thus, the boundary surface between the film sheet and the expanded article is smooth." The

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Examiner respectfully disagrees because Applicant's arguments are directed to process limitations and they are not commensurate in scope with the claims. Claims do not require "article is prepared by concurrently performing a steam expansion molding operation on the starch and an adhesion operation" as asserted by Applicant. Further, it is not clear as to what is meant by the "boundary surface". The Examiner interprets this to be the surface of the molded article, which is being claimed as an irregular surface. As set forth above in Section 5, Doane reference meets the claim requirement of the biodegradable expanded molded article having an irregular surface.

With respect to the art rejections of Bradt, Shogren and Altieri, Applicant has generally asserted his/her disagreement with the Examiner's rejection, but did not specifically pointed out the errors in the Examiner's rejection. Therefore, the Examiner's comments set forth above in this and in the previous Office Action are equally pertinent to these rejections as well. Accordingly, art rejections are maintained.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth M. Cole/
Primary Examiner,
Art Unit 1794

/A. D./
APD